REMARKS

Claims 1-10 are currently under consideration. In this Response, Applicant has not amended or cancelled any of the claims. Applicant has not added any claims. Applicant respectfully requests reconsideration and allowance of the application.

Rejections under the Judicially Created Doctrine of Double Patenting

Claims 1-10 stand rejected under the judicially created doctrine of double patenting over claims 1, 11, 12, and 29 of U.S. Patent No. 6,132,823 ("the '823 patent"). In support of this rejection, the Examiner re-asserts the arguments originally set out in the Office Action mailed September 11, 2002. That Office Action stated that:

> "the claims, if allowed, would improperly extend the 'right to exclude' already granted in the patent. The subject matter claimed in the instant application is fully disclosed in the patent and is covered by the patent since the patent and the application are claiming common subject matter, as follows: a thermally conductive heat transfer layer containing the instantly claimed compounds and method for treating the compounds. Furthermore, there is no apparent reason why applicant was prevented from presenting claims corresponding to those of the instant application during prosecution of the application which matured into a patent."

The precise rationale forming the basis of this rejection is unclear. Specifically, it is incumbent upon the PTO to enumerate, by comparison of the rejected claims with the claims in the patent, the reasons why -- if the rejection is a so-called "obvious double patenting type rejection -- the rejected claims would be obvious from those patented claims. Here, the PTO has not done so.

The rejected claims state a functional structure having a particular thermal conductivity. A review of the patent claims (Nos. 1, 11, 12, and 29) does not show either such a structure or a thermal conductivity value.

It should be noted that the claims in the patent are drafted in the form of a composition. The instant claims drawn to a heat transfer structure.

Applicant respectfully disagrees with this rejection and submits that it is improper.

If, on the other hand, if the rationale of the PTO is based simply on the stated basis and not on an "obviousness" determination, then it is similarly improper. That is: if this is the type of nonstatuory double patenting rejection purportedly justified solely to prevent an "unjustified timewise extension" of the right to exclude [*i.e.,* a double patenting rejection based on the *Schneller* case as explained in MPEP §804(II)(B)(2)], then is similarly improper. As noted in that MPEP section, double patenting rejections based on *Schneller* **will be rare** (emphasis in original). In fact, these rejections are so rare that the Technology Center Director *must* approve any nonstautory double patenting rejections based on *Schneller*. The MPEP states that the proper procedure to follow for such a rejection is as follows: "If an examiner determines that a double patenting rejection based on Schenller is appropriate in his or her application, the examiner should first consult with his or her supervisory patent examiner (SPE). If the SPE agrees with the examiner then approval of the TC Director *must* be obtained before such a nonstatutory double patenting rejection can be made." *Id.* (emphasis added). Applicant notes that no such approval from the TC Director has been indicated in any of the Office Actions rejecting claims 1-10 under this *Schneller*-type double patenting.

Accordingly, Applicant respectfully submits that the rejection is improper and should be withdrawn.

Rejections under 35 U.S.C. §102(a)

Claims 1 and 6 stand rejected under 35 U.S.C. §102(a) as being anticipated by U.S. Patent No. 5,542,471 to Dickenson et al. ("Dickenson"). In support of this rejection the Office

Action states, "Dickenson teaches a heat transfer element comprising a highly conductive thermal fiber on a substrate (col. 8, lines 52-29 and col. 4, lines 5-18). The reference is anticipatory." Applicant disagrees with this rejection.

The undersigned has exchanged several voicemails with the Examiner in efforts to expedite the prosecution of this case. During those voicemail exchanges, the Dickenson reference was mentioned as a one that didn't seem to be related to the claimed subject matter. Specifically, the undersigned explained why the reference is not anticipatory, as it fails to teach each and every element of the present claims (*e.g.*, a heat conducting medium "having a thermal conductivity substantially greater than silver" or a heat conducting medium "having a thermal conductivity which substantially increases above an activation temperature"). In a voicemail message of August 26, 2003, the Examiner stated that the rejections under 35 U.S.C. §102(a) over Dickenson were improper and should probably be withdrawn.

Accordingly, Applicant respectfully requests that the rejection under 35 U.S.C. §102(a) be withdrawn.

CONCLUSION

Applicant has responded to each matter of substance raised in the Office Action and submits that the case is in condition for allowance. Should the Examiner have any requests, questions, or suggestions, he is invited to contact the applicant's attorney at the number listed below.

In the unlikely event that the transmittal letter is separated from this document and the Patent Office determines that an extension and/or other relief is required, Applicant petitions for any required relief including extensions of time and authorizes the Commissioner to charge the cost of such petitions and/or other fees due in connection with the filing of this document to **Deposit Account No. 03-1952** referencing docket no. 458172000100. However, the Commissioner is not authorized to charge the cost of the issue fee to the Deposit Account.

Dated: October 1, 2003

Respectfully submitted,

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